

## **REMARKS**

In the Office Action dated July 23, 2002, the Examiner: (1) objects to the specification; (2) objects to the drawings; (3) rejects claims 59-74 under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification; (4) rejects claims 59-74 under 35 U.S.C. 112, second paragraph, as being indefinite; (5) rejects claims 59-74 under 35 U.S.C. 102(a) and/or 102(b) and/or 102(c) as being anticipated by various references; and (6) rejects claims 61-62 under 35 U.S.C. 103(a) as being obvious over various references.

### **I. OBJECTIONS TO THE SPECIFICATION**

The Examiner objected to the specification for failing to provide proper antecedent basis for the "receiving portion" as recited in claim 63. Although Applicant believes that the specification supports a "receiving portion," Applicant has amended claim 63 to recite a "receptacle."

### **II. OBJECTIONS TO THE DRAWINGS**

#### **A. 37 CFR 1.83(a)- Claimed features not in drawings**

The Examiner objects to the drawings for not showing every feature of the invention specified in the claims. Specifically, the Examiner states that the following features must be shown or cancelled from the claims:

- (a) The "means for limiting reciprocation" as recited in claim 60; and
- (b) The "receiving portion" as recited in claim 63.

With respect to (a), Applicant asserts that there are many examples of "means for limiting reciprocation" shown in the drawings. For example, referring to page 10, paragraph [0041] and Figures 7-9, engagement of threads 50 to threads 50' and friction member 60 are both described as "means for limiting reciprocation." Therefore, Applicant asserts that the "means for limiting reciprocation" are shown in the drawings.

With respect to (b), Applicant asserts that in light of the amendment to claim 63, the objection is moot.

**B. 37 CFR 1.83(a)- New drawings suggest new matter**

The Examiner also rejects to the drawings, requesting that the Applicant explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes.

**1. Figures 6A and 6B**

Figures 6A and 6B were filed in a preliminary amendment dated October 1, 2001 to add explicit support for original claims 38 and 39. Additionally, the specification discusses embodiments shown in these Figures in at least Paragraphs 0031, 0032, and 0040. Specifically, in Figure 6A, show aspects of the previously-described block 30 is disposed partially through hole 22a, block 30 thus being inserted through a portion of receptacle 22 (see original claim 38). In addition, reference numeral 36 has been added to Figure 6A. Reference numeral 36 finds support on page 7, paragraph [0032], line 3 of the substitute specification.

In Figure 6B, block 30 is disposed to be partially through hole 22a and hole 22b, block 30 thus being inserted through all of receptacle 22 (see original claim 39).

Because there is support for Figures 6A and 6B at least in originally filed claims 38 and 39, Figures 6A and 6B do not constitute new matter.

**2. Figures 15 and 16**

New Figures 15 and 16 were added in the response to the Office Action dated November 27, 2001. Support for these figures can be found, for example, on page 8, paragraphs 0035-0036 and Figure 12 of the substitute specification. Figures 15 and 16 were filed to show the previously-described mounting portion 20 being connected to a wall. This disclosure was part of the original specification, and therefore does not constitute new matter.

**C. 37 CFR 1.84(p)(4)- Reference characters used more than once**

The Examiner objects to the drawings because reference character "22" has been used to designate both a "receptacle" and "a mounting portion receptacle." In response, Applicant asserts that the receptacle and mounting portion receptacle are indeed the same component; receptacle is simply a shortened term for mounting portion receptacle. Therefore, Applicant respectfully suggests that a proposed drawing correction is unnecessary.

**D. 37 CFR 1.121(a)(6)- Claimed features introduce new matter**

The Examiner objects to the drawings under 37 CFR 1.121(a)(6) because the proposed drawing corrections introduce new matter into the drawings. Specifically, the Examiner states that the original disclosure does not support the showing of "a wall of immovable structure," as recited

in new claims 59 and 68. However, at page 8, paragraph [0036], lines 5-6 Applicant specifically describes the mounting portion being “connected to a garage wall or, alternatively, the wall of a dwelling or storage warehouse.” Garage, dwelling, and storage warehouse are each examples of an immovable structure. Therefore, Applicant respectfully requested that this rejection be withdrawn.

### **III. 112, FIRST PARAGRAPH REJECTIONS**

The Examiner rejects claim 63 because “it is not known what is the ‘receiving portion.’” As mentioned above, Applicant has amended claim 63 to recite “receptacle” instead, thereby making the rejection moot.

The Examiner rejects claims 59-74 because “a wall of an immovable structure” is considered new matter. As previously shown, the specification provides support for “a wall of an immovable structure.”

### **IV. 112, SECOND PARAGRAPH REJECTIONS**

The Examiner rejects claims 59, 63 and 68 because “it is unclear whether the Applicant is claiming the subcombination of an apparatus or the combination of an apparatus and a wall.” In response, Applicant asserts that claims 59 and 68 are directed to the combination of an apparatus and a wall because both elements are present in the body of the claims. Claim 63, on the other hand, is directed to the subcombination of an apparatus because only the apparatus is present in the body of the claim.

The Examiner further rejects claim 63 because “it is unclear what structural elements make up the ‘receiving portion’”. As described above, Applicant has amended claim 63 to recite “receptacle,” thereby making the rejection moot.

The Examiner rejects claim 73 because “it is unclear whether the Applicant is claiming the subcombination of an apparatus or the combination of an apparatus and a vehicle storage compartment.” In response, Applicant asserts that claim 73 is directed to the combination of an apparatus and a vehicle storage component because both elements are present in the body of the claim.

Applicant asserts that because the subcombination of the apparatus is patentable, the combination of the apparatus and a wall, or alternatively a vehicle storage compartment, is also patentable.

## V. 102 REJECTIONS

The Examiner (1) rejects claims 59 and 60 under 35 U.S.C. 102(a) as anticipated by U.S. Patent No. 419,505 (*Deerman*); (2) rejects claims 61 and 62 under 35 U.S.C. 102(a) as anticipated by *Deerman* in combination with U.S. Patent No. 5,476,279 (*Klemetsen*); (3) rejects claims 59-74 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,938,399 (*Hull et al.*); and (4) rejects claims 59-74 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,991,865 (*Francisco*). Applicant traverses the rejections for at least the following reasons.

### A. The Examiner Fails to Establish How the References Anticipate the Claims

First, Applicant respectfully asserts that the Examiner failed to establish how the references anticipate claims 59-74. “[I]t is incumbent upon the Patent Office ... to set forth clearly why it regards a claim to be anticipated....” *In re Mullin*, 481 F.2d 1333, 1336, 179 U.S.P.Q. 97, 100 (C.C.P.A. 1973). An Examiner may not merely assert that a particular reference anticipates a claim. For example, in *Mullin*, the court found the examiner’s assertion that “Claims 1-5 are rejected as obviously anticipated by [a reference] under 35 U.S.C. 102” did not necessarily inform the applicant why the claims were regarded as defective. *Id.* at 1336-37, 179 U.S.P.Q. at 100.

Furthermore, a complete explanation of the grounds for rejection is required under the Rules. See 37 C.F.R. 1.104(c)(2), which reads:

(c) Rejection of claims. . .

(2) In rejecting claims for want of novelty or for obviousness, the examiner must **cite** the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added).

In the present Office Action, the Examiner’s conclusory statements do not satisfy this initial burden.

### B. None of the References Anticipates the Claims

Second, none of the references anticipates the claims or renders the claims obvious. To anticipate a claim, a single reference must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Applicant asserts that *Deerman*, *Klemetsen*, *Hull et al.* and *Francisco* do not anticipate Applicant’s claimed invention because none of them contains all of the elements of the claims.

### **1. Deerman**

*Deerman* is a design patent, which discloses an ornamental design for a cover for a trailer hitch receiver.

### **2. Klemetsen**

*Klemetsen* discloses a trailer hitch, including a structural frame 2 member, which receives a tow bar 6 or hitch ball 7 assembly, and includes a way to attach the structural member to a towing vehicle. The trailer hitch further provides a way to mount one or more tow bar assemblies 16, on, and in, the structural frame 2.

### **3. Hull et al.**

*Hull et al.* disclose a load carrying apparatus that attaches to the trailer hitch or receiver of a vehicle 10 that provides a secondary hitch 19 or receiver on the apparatus to enable the towing vehicle 10 to carry a load on the carrying apparatus while still being able to tow a trailer 12 or boat-trailer of the like.

### **4. Francisco**

*Francisco* discloses an automatic trailer hitch 10 for use with a draft vehicle. The hitch 10 contains devices for attaching its two ends to a trailer 12 and to a vehicle 14 for towing the trailer 12. When the hitch 10 is being connected to the vehicles, it may be extended in length; the presence of at least two telescoping members 28,30,32 in the hitch 10 allows such extension. Once the hitch 10 has been connected to the vehicles, the towing vehicle 14 may be backed towards the draft vehicle, thereby contracting the length of the hitch 10. A locking mechanism 44, comprised of a spring-loaded pawl 46, locks the hitch 10 into its contracted position once it has reached a certain specified minimum length.

#### **a) Claim 59**

Claim 59 is directed to an apparatus for converting a trailer hitch apparatus to a temporary storage device mounted to a wall, which includes a wall, a receptacle having a first end and a second end, the receptacle capable of coupling to the trailer hitch apparatus, a mount disposed on the first end of the receptacle, and the mount coupled to the wall and the second end of the receptacle extending into the wall.

In contrast, in *Deerman*, a cover and a trailer hitch receiver are shown. Although the Examiner refers generally to Figure 2, it is unclear to Applicant what in *Deerman* the Examiner regards as each of the claim elements because *Deerman* is a design patent having no textual

description. What is clear is that Figure 2, and *Deerman* in general, at least fails to teach a wall of an immovable structure and an end of a receptacle extending into the wall, as recited by claim 59.

In addition, both *Klemetsen* and *Francisco* also at least fail to teach a wall of an immovable structure and an end of a receptacle extending into the wall, as recited by claim 59. Because none of the references cited contains all of the claim limitations of independent claim 59, Applicant asserts that the references do not anticipate claim 59.

Based on the foregoing, Applicant respectfully submits that claim 59, and all claims which depend from claim 59 (claims 60-62), should be allowed. Because claim 59 is allowable, dependent claims 60 and 62 are also allowable. Therefore, the Examiner's inherency argument is moot. However, Applicant will add that the use of the holes in *Deerman* is purely speculation, which cannot form the basis of an inherency rejection.

#### **b) Claim 63**

Claim 63 is directed to an apparatus for converting a trailer hitch apparatus to a temporary storage device mounted on a wall, which includes a receiving portion having a first end and a second end, the receiving portion capable of being removably coupled to the trailer hitch apparatus, a mounting portion being disposed at the first end of the receiving portion, and the receiving portion capable of extending into the wall such that the first end is substantially flat with the wall and the second end extends into the wall.

Both *Klemetsen* and *Francisco* at least fail to teach a receptacle extending into a wall such that a mounting portion is substantially flat with the wall, as recited by claim 63. Because neither of the references cited contain all of the claim limitations of independent claims 63, Applicant asserts that the references do not anticipate claim 63.

Based on the foregoing, Applicant respectfully submits that claim 63, and all claims which depend from claim 63 (claims 64-67), should be allowed.

#### **c) Claim 68**

Claim 68 is directed to a device for converting a trailer hitch apparatus to a temporary storage device, which includes a wall, a mounting portion receptacle having first and second ends, and a mounting portion having an opening and being disposed on the first end of the mounting portion receptacle, the mounting portion being coupled to the wall, wherein the mounting portion comprises a flange.

Both *Klemetsen* and *Francisco* at least fail to teach a wall of an immovable structure and a mounting portion coupled to the wall, as recited by claim 68. Because neither of the references

cited contain all of the claim limitations of independent claim 68, Applicant asserts that the references do not anticipate claim 68.

Based on the foregoing, Applicant respectfully submits that claim 68, and all claims which depend from claim 68 (claims 69-72), should be allowed.

**d) Claim 73**

Claim 73 is directed to an apparatus for converting a trailer hitch apparatus to a temporary storage device, which includes a vehicle storage compartment having a bottom, a plurality of sides and a top, each of the side coupled to the bottom and to adjacent of the plurality of sides, and the top coupled to at least one of the plurality of sides; a receptacle having first and second ends; a mount disposed on the first end of the receptacle; and the receptacle being coupled to one of the plurality of sides such that the mount is disposed substantially flat on the one of the plurality of sides and the second end extends into the vehicle storage compartment.

Both *Klemetsen* and *Francisco* at least fail to teach a vehicle storage compartment and fail to teach a vehicle storage compartment having a receptacle attached thereto, as recited by claim 73. Because neither of the references cited contains all of the claim limitations of independent claim 73, Applicant asserts that the references do not anticipate claim 73.

Based on the foregoing, Applicant respectfully submits that claim 73, and all claims which depend from claim 73 (claim 74), should be allowed.

**C. Functional Language**

The Examiner states that he gives little patentable weight to functional recitation using the word "for" because it allegedly fails to add structural limitations and is thereby regarded as intended use language. Applicant submits that structural limitations which define and distinguish Applicants invention from the prior art are present in the body of the claims.

**D. Claim Language Meaning**

The Examiner requests that Applicant expressly state whether all claim limitations should be given their ordinary and accustom meaning. The terms used in the application are intended to have their customary and ordinary meaning. The disclosure should not be interpreted as disclaiming any portion of a term's ordinary meaning. Rather, unless specifically stated otherwise, definitions or descriptions disclosed herein are intended to supplement, *i.e.*, be in addition to, the scope of the ordinary and customary meaning of the term or phrase.

### **E. "Means for" Language**

The Examiner asserts that the "means for" phrases in the claims to not invoke 35 U.S.C. 112, sixth paragraph, and requests that Applicant either amend the claims to remove all instances of "means for" or expressly state Applicant's desire to invoke 35 U.S.C. 112, sixth paragraph. In response, it is the Applicant's intent that the "means for" language invoke 35 U.S.C. 112, sixth paragraph.

### **VI. 103 REJECTIONS**

The Examiner rejects claims 61 and 62 under 35 U.S.C. 103(a) as being unpatentable over *Deerman* in combination with *Klemetsen*. Applicant traverses the rejection for at least the following reasons.

First, Applicant asserts that the claims are not obvious in view of the cited references; a *prima facie* case of obviousness is not supported because there is no motivation to combine the references. When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the reference. *Winner Intern. Royalty Corp. v. Wong*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). The showing of such combinability must be "clear and particular." *Id.* at 1349. Applicant respectfully suggests that the Examiner has failed to establish the requisite motivation to combine the cited references. As detailed below, the Federal Circuit requires the PTO to strictly comply with the motivation to combine requirement.

For example, in *In re Dembiczak*, 175 F. 3d 994 (Fed. Cir. 1999), the Federal Circuit reversed the PTO's obviousness rejection of certain claims because the PTO failed to provide a sufficient suggestion to support the proposed combination. The Federal Circuit noted that references cannot be combined unless supported by a sufficient teaching, motivation or suggestion in the art to prevent the "subtle but powerful attraction of a hindsight-based obviousness analysis." *Id.* at 4. The Court expounded on the importance of not analyzing the obviousness of claims using an Applicant's disclosure in hindsight and noted that the § 103 phrase "at the time the invention was made" guards against the "tempting but forbidden zone of hindsight." *Id.* at 4. The Court then reversed the PTO's rejection because the PTO "fell into the hindsight trap" by failing to "particularly identify any suggestion, teaching, or motivation to combine the [prior] art references...." *Id.* at 4-5. The Court admonished the PTO for merely describing in detail "the similarities between the [cited] references and the claimed invention." *Id.* at 5. In the present case,



the examiner has not particularly identified *any* motivation to combine *Deerman* and *Klemetsen*. Therefore, Applicant respectfully suggests that the rejection be withdrawn.

Second, even assuming that a motivation to combine can be identified, even the combination of *Deerman* and *Klemetsen* fails to teach all of the elements of claims 61 and 62 because they at least do not disclose or teach a wall of an immovable structure and an end of a receptacle extending into the wall.

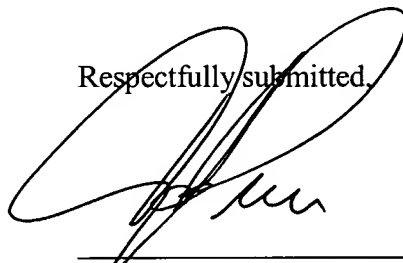
For at least these reasons, Applicant respectfully requests that the rejections be withdrawn and that the claims be allowed.

## Conclusions

During the course of these remarks, Applicant has at times referred to particular limitations of the claims which are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. They are as required by law. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction. Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and was not an amendment for the purpose of patentability. Further, although Applicant has amended certain claims, Applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

Reconsideration of the newly submitted claims and the allowance thereof is respectfully requested. Applicant invites the Examiner to contact the undersigned to conduct an interview should an interview expedite the resolution of this application.

Respectfully submitted,



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